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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,292	09/11/2003	Hiromichi Itoh	500.31833CC5	5613

24956 7590 06/07/2006

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SUITE 370
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EXAMINER	
DUNCAN, MARC M	

ART UNIT	PAPER NUMBER
2113	

DATE MAILED: 06/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/659,292	ITOH ET AL.	
	Examiner	Art Unit	
	Marc Duncan	2113	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 September 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *11 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 08/001,248.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Status of the Claims

Claims 5, 6, 8, 9, 11, 18, 19 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-4 and 6-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Allard et al. (5,432,946).

Claims 1-2, 6-12 and 16-24 are rejected on the ground of nonstatutory double patenting.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5, 6, 8, 9, 11, 18, 19 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation "said switch controller" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 9 recites the limitation "said network" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claims 6, 8, 18, 19 and 21 all contain the limitation "even if portions other than said communication module are in a power-off state via said power supply line" or some variation thereof. This limitation does not appear to be in proper English and does not make sense. As currently written, the phrase "via said power supply line" necessarily modifies the portions other than the communication module that are in a power-off state. The examiner believes, after a reading of the specification, that the phrase "via said power supply line" was intended to modify the communication module, i.e. the communication module being supplied with power via the power supply line even when other portions of the system were powered off. Claim 9 depends from claim 8 and therefore contains all limitation of claim 8 and is likewise rejected.

Claim 11 contains the limitation "wherein when said power supply module receives power-on request from said power supply module." This limitation does not make sense. The examiner assumes that the power supply module in claim 11 is intended to receive the power-on request from the communication module and has examined the claim against the prior art using this interpretation.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4 and 6-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Allard et al. (5,432,946).

Regarding claim 1:

Allard teaches:

a processing unit (Fig. 3 – 32);

a power supply module (Fig. 2 – 90);

a communication module for connecting with a network (Fig. 5 – 110 and col. 7 lines 29-31);

a power supply line for connecting said power supply module to said processing unit (col. 5 lines 39-43 – the power supply supplies power to the components and therefore a power supply line is necessarily present); and

a power control line for connecting said communication module and said power supply module (col. 7 lines 55-57), wherein said power supply module receives a power-on request via said power control line (col. 8 lines 33-35), and supplies power to said processing unit via said power supply line based on said power-on request (col. 8 lines 33-35).

Regarding claim 2:

Allard teaches:

wherein said communication module receives a frame transmitted from another network connectable equipment connected to said network (col. 8 lines 22-27), discriminates if the received frame is destined to said network connectable equipment

(col. 8 lines 22-27), and if the received frame is destined to said network connectable equipment, transmits said power-on request to said power supply module via said power control line (col. 8 lines 27-35).

Regarding claim 3:

Allard teaches:

wherein said power supply module comprises: a switch for turning on and off power supplied to said processing unit (Fig. 4 – 101 and col. 6 lines 58-68); and a switch controller for controlling the switch (Fig. 4 – 91,92 and col. 6 lines 58-68), wherein said switch controller supplies power to said power supply line based on said power power-on request by controlling said switch (col. 6 line 51-col. 7 line 8 and col. 8 lines 27-35).

Regarding claim 4:

Allard teaches:

wherein said power supply module is connected to an interrupt signal line for sending an interrupt signal to said processing unit, and sends said processing unit a request to start processing for turning off power via said interrupt signal line (col. 8 lines 41-45 – a timeout is a type of interrupt. The timeout starts the power down function of the system).

Regarding claim 6:

Allard teaches:

wherein said power supply module supplies power to said communication module even if portions other than said communication module are in a power-off state via said power supply line (col. 7 lines 61-66).

Regarding claim 7:

Allard teaches:

a power control line (col. 7 lines 55-57);

a communication module connected to said power control line (Fig. 5 – 110 and col. 7 lines 29-31);

a power supply line (col. 5 lines 39-43 – the power supply supplies power to the components and therefore a power supply line is necessarily present);

a processing unit connected to said power supply line (Fig. 3 – 32 and col. 5 lines 39-43); and

a power supply module (Fig. 2 – 90) connected to said power supply line and said power control line, wherein said power supply module receives a power-on request via said power control line (col. 8 lines 33-35), and supplies power to said processing unit via said power supply line based on said power-on request (col. 8 lines 33-35).

Regarding claim 8:

Allard teaches:

wherein said power supply module supplies power to said communication module even if portions other than said communication module are in a power-off state via said power supply line (col. 7 lines 61-66).

Regarding claim 9:

Allard teaches:

wherein said communication module receives a frame transmitted from another network connectable equipment connected to said network (col. 8 lines 22-27), discriminates if the received frame is destined to said network connectable equipment (col. 8 lines 22-27), and if the received frame is destined to said network connectable equipment, transmits said power-on request to said power supply module via said power control line (col. 8 lines 27-35).

Regarding claim 10:

Allard teaches:

a communication module connected to said network (Fig. 5 – 110 and col. 7 lines 29-31);

a power supply module for supplying power to said communication module (Fig. 2 – 90 and col. 7 lines 61-66);

a power supply control line connected to said communication module and said power supply module (col. 7 lines 55-57);

a power supply line connected to said first equipment and said power supply module (col. 5 lines 39-43 – the power supply supplies power to the components and therefore a power supply line is necessarily present), wherein said communication module receives a frame transmitted from a second equipment connected to said network (col. 8 lines 22-27), discriminates if the received frame is destined to said first equipment (col. 8 lines 22-27), and transmits a power-on request to said power supply module via said power control line upon determination that said received frame is destined to said first equipment (col. 8 lines 27-35), and wherein said power supply module enables power to be supplied to said first equipment in response to said power-on request via said power supply line (col. 8 lines 33-35).

Regarding claim 11:

Allard teaches:

A power supply module (Fig. 2 – 90), included in a network connectable equipment having a processing unit (Fig. 3 – 32) and a communication module (Fig. 5 – 110), comprising:

wherein said power supply module is connectable to a power control line which is connected to said communication module and is connectable to a power supply line (col. 7 lines 55-57) which is connected to said processing unit (col. 5 lines 39-43 – the power supply supplies power to the components and therefore a power supply line is necessarily present), and wherein when said power supply module receives power-on request from said power supply module via said power control line, said power supply

module supplies power to said processing unit via said power supply line based on said power-on request (col. 8 lines 33-35).

Regarding claim 12:

Allard teaches:

wherein said power module always supplies power to said communication module (col. 7 lines 61-66), and wherein said power supply module receives a power-on request via said power control line, when said communication module receives a frame transmitted from another network connectable equipment connected to said network (col. 8 lines 22-27), discriminates if the received frame is destined to said network connectable equipment (col. 8 lines 22-27), and if the received frame is destined to said network connectable equipment, transmits said power-on request to said power supply module via said power control line (col. 8 lines 27-35).

Regarding claim 13:

Allard teaches:

a storage unit (Fig. 3 – 38);

a display unit (Fig. 1 – 11);

a network controller for connecting said information processing apparatus to a network (Fig. 5 –110);

a processing unit for executing processing in accordance with contents of processing stored in said storage unit (Fig. 3 – 32);

a power supply controller for supplying said network controller with electric power even if said information processing apparatus remains in a power-off state (Fig. 2 – 90 and col. 7 lines 61-66); and

a power supply switch controller (Fig. 4 – 91,92 and col. 6 lines 58-68) for instructing a power-on state of said information processing apparatus when said network controller receives a frame from said network while said information processing apparatus remains in the power-off state (col. 8 lines 22-27), thus turning said information processing apparatus from the power-off state to the power-on state (col. 8 lines 27-35).

Regarding claim 14:

Allard teaches:

wherein said network controller identifies whether the received frame is to turn said information processing apparatus to the power-on state (col. 8 lines 22-27).

Regarding claim 15:

Allard teaches:

wherein said power supply switch controller is included in said power supply controller (Fig. 4).

Regarding claim 16:

Allard teaches:

a communication module for connecting with a network (Fig. 5 – 110); and

a power supply line for connecting a power supply module to said communication module (col. 7 lines 61-66), wherein said power supply module supplies power to said communication module via said power supply line (col. 7 lines 61-66).

Regarding claim 17:

Allard teaches:

a processing unit connected to said power supply line (Fig. 3 – 32 and col. 5 lines 39-43 – the power supply supplies power to the components and therefore a power supply line is necessarily present).

Regarding claim 18:

Allard teaches:

wherein said power supply module supplies power to said communication module even if portions other than said communication module are in a power-off state via said power supply line (col. 7 lines 61-66).

Regarding claim 19:

Allard teaches:

a power control line for connecting said communication module and said power supply module (col. 7 lines 55-57), and wherein said power supply module supplies power to said processing unit via said power supply unit based on a power-on request

sent from said communication module even if portions other than said communication module are in a power-off state via said power supply line (col. 7 lines 61-66 and col. 8 lines 22-35).

Regarding claim 20:

Allard teaches:

a power unit (Fig. 2 – 90);

a power supply controller (Fig. 4 – 91,92);

a first line for connecting said power unit and said power supply controller (Fig. 4 – the power supply controller is part of the power unit as a whole. There are lines that connect the power supply controller to the actual power source, as seen in Fig. 4);

a communication module for connecting with a network (Fig. 5 – 110);

a second line for connecting said power supply controller to portions in said network connectable equipment (col. 5 lines 39-43 – the power supply supplies power to the components and therefore a power supply line is necessarily present); and

a third line for connecting said communication module and said power supply controller, wherein said power supply controller controls a destination of the power supplied by said power (col. 7 lines 55-57 and col. 8 lines 22-35).

Regarding claim 21:

Allard teaches:

wherein said power supply controller supplies power to said communication module even if portions other than said communication module are in a power-off state via said second line (col. 7 lines 61-66).

Regarding claim 22:

Allard teaches:

a processing unit (Fig. 3 – 32), wherein if said power supply controller receives a power-on request via said third line (col. 8 lines 27-35), said power supply controller supplies power to said processing unit via said second line based on said power-on request (col. 8 lines 27-35).

Regarding claim 23:

Allard teaches:

wherein said power supply controller supplies power to portions other than said processing unit via said second line after it supplies power to said processing unit (col. 5 lines 39-43).

Regarding claim 24:

Allard teaches:

a power unit (Fig. 2 – 90);

a first device (Fig. 3 – 32);

a second device (Fig. 5 – 110);

a first line for connecting said power and said first device (col. 5 lines 39-43); and

a second line for connecting said power and said second device (col. 7 lines 55-57), wherein said power unit supplies power to said first line in response to a signal sent from said second device when said first line is in a power-off state and said second line is in a power-on state (col. 8 lines 22-35).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8, 11-16, 19-21 and 24-34 of patent #6,662,311 contain(s) every element of claims 1-2, 6-12 and 16-24 of the instant application and as such anticipate claims 1-2, 6-12 and 16-24 of the instant application.

While the claims of patent #6,662,311 do not contain an explicit teaching of the lines connecting the various modules of the claimed system, it is inherent to the

structure and function of the claimed system to include a line connecting the power supply and the processing unit, a line connecting the communication module and the power controller and a line connecting the power controller and the power source.

Claims 1-6 of patent #5,721,932 contain(s) every element of claims 1-2, 6-12 and 16-24 of the instant application and as such anticipate claims 1-2, 6-12 and 16-24 of the instant application.

While the claims of patent #5,721,932 do not contain an explicit teaching of the lines connecting the various modules of the claimed system, it is inherent to the structure and function of the claimed system to include a line connecting the power supply and the processing unit, a line connecting the communication module and the power controller and a line connecting the power controller and the power source.

Claim 40 of patent #5,592,675 contain(s) every element of claims 1, 6, 7, 8, 11, 16, 17, 18, 19 and 24 of the instant application and as such anticipate claims 1, 6, 7, 8, 11, 16, 17, 18, 19 and 24 of the instant application.

While the claims of patent #5,592,675 do not contain an explicit teaching of the lines connecting the various modules of the claimed system, it is inherent to the structure and function of the claimed system to include a line connecting the power supply and the processing unit, a line connecting the communication module and the power controller and a line connecting the power controller and the power source.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Duncan whose telephone number is 571-272-3646. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Beausoliel can be reached on 571-272-3645. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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